

#### **IV. REMARKS**

##### **Status of the Claims**

Claims 32 and 42 are amended. Claims 39 and 41 have been rewritten in independent form. Claims 32-45 remain under consideration.

##### **Summary of the Office Action**

Claims 32-38, 40, and 42-45 stand rejected under 35USC103(a) on the basis of the cited reference Johansson, U.S. Patent No. 5,913,163. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks. Claims 39 and 41 have been indicated to contain patentable subject matter if rewritten in independent form. Accordingly applicant has rewritten claims 39 and 41 in independent form and submits that these claims are now allowable.

##### **The Invention**

A mobile telephone having full capability of communication with a network in a well known manner is also equipped with a local communication module connected to generate a bidirectional local wireless communication link for transmission and reception of communications with an accessory, such as a head set, user interface, or the like, which is adapted to be supported on the person of said user. The local communications link uses time division multiple access with frequency hopping or code controlled multiple access with individual pseudorandom binary sequencing to avoid interference with said radio telephone network communication. The accessory is designed to communicate only over the local communications link with the local communication module of the radio telephone.

## Discussion of the Cited References

The Examiner relies primarily on the reference Johansson to support the rejection based on obviousness. The cited reference describes a system in which multiple communication devices are linked together in a local area communication system. Each of the devices is linked to the "LACS" by a local interface module that is capable of transforming a non-local communication signal into a local transmission signal. The purpose of this system is to allow a subscriber to more freely roam between private and public systems, for example cellular and cordless systems which use different protocols. (see column 1, lines 35-40). It is also a purpose of the system of Johansson to provide a headset capable of communicating on a single protocol with both a cordless system and with a mobile station (see column 2, lines 44-47).

In support of the rejection, the Examiner states that Johansson discloses a radio telephone (810) comprising a transceiver (830) and a controller (860), and a first remote unit (220) having a transceiver (830) and a controller (860).

A close review of the cited reference reveals, that the reference 810 of Johansson relates to a wireless headset which can communicate with a local interface module 905-A, - 905-E via a local communication link. The wireless headset is not a radio telephone as in the subject application.

The headset is one of the local communication devices of the cited reference. These devices can be connected with a mobile station, a directly connectable home base station associated with a PSTN, a serial computer port connector, an electronic data

terminal or a cordless phone base unit. The local communication device of Johansson is described as follows in column 3, lines:

**"Each of the locally-positioned communication devices is also provided with a corresponding local interface module wherein the local interface module is capable of receiving an incoming communication signal and transforming it into a local transport signal suitable for local transmission in accordance with at least one preselected common protocol."**

This indicates that each of the units connected within the local network is capable of receiving signals from external sources through its associated local interface module. With its local interface module it is a self sufficient device for operation on both a cellular and a cordless system.

The claims of this application are directed to a mobile telephone having accessories operationally connected though a wireless communication link using cellular protocols. The mobile phone is the controller for a limited communication link, the range of which is the immediate vicinity of the user. The system of this invention is simple. It does not include a cordless network controller and other devices which are interconnected through the local interface modules of the myriad local communication devices of the cited reference.

The accessories (remote units) of the subject mobile telephone of this invention communicate only with the mobile telephone over the local communication link which is generated and controlled by the mobile telephone. The remote units of this application are not the same, therefore as the local communication devices of the cited reference. They do not communicate, like the headset cited by the Examiner, in both local and external systems.

This difference is illustrated by the different ways in which the PSTM and cellular calls are handled in steps 1005/1020, see

column 10, lines 20-55. None of these decisions arise in the system of the subject application.

Applicant submits therefore that the teaching of the cited reference Johansson has more significant deficiencies than are indicated by the Examiner. The Examiner's official notice of the TDMA and spread spectrum techniques does not remedy these deficiencies.

### **The Issue of Obviousness**

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of Johansson, in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a modification would be desirable.

The Examiner is again reminded that, the claims should be considered as a whole and not dismantled. The individual features should not be pursued, except in the context of the entire claim. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

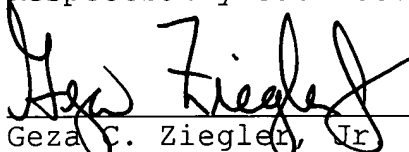
The use of a system designed to communicate between multiple devices in a cordless system and a cellular system is far too complex and expensive to be used for communicating between a mobile telephone and its accessories, all of which are located on the person of the user.

The above remarks apply equally to the rejection as applied to all of the claims.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$506.00 is enclosed for a two month extension of time and additional claim fees. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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13 May 2004  
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